IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of :

COMMEREUC *et al.* : Examiner: NGUYEN, TAM M.

Serial No.: 09/580,179 : Group Art Unit: 1764

Filed: May 26, 2000 :

For: CATALYST COMPRISING A TRIOCTAHEDRAL 2:1 PHYLLOSILICATE PREPARED IN A FLUORIDE MEDIUM AND A PROCESS FOR THE HYDROCONVERSION OF PETROLEUM FEEDS

RESPONSE TO REQUIREMENT FOR RESTRICTION

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Requirement for Restriction mailed on May 17, 2002, Applicants hereby elect group I, claims 1-11 and 17-20, drawn to the catalyst composition. The Requirement for Restriction is respectfully traversed.

The examiner's reasons for restriction do not take into account that if the present claims directed to the catalyst are found to be allowable, then any group II dimerization oligomerization process based on the use of a catalyst having the same scope of the allowed group I would, ipso facto, also be allowable. This is because, at least in the catalyst area and probably beyond, it is per se non-obvious to use a material which itself is non-obvious. See *In re Kuehl*, 177 U.S.P.Q. 250 (CCPA 1973); *In re Brouwer*, 37 U.S.P.Q.2d 1663 (Fed. Cir. 1996); *In re Ochiai*, 37 U.S.P.Q.2d 1127 (Fed. Cir. 1995). Thus, once the catalysts are found allowable, the process claims are also clearly allowable, and no additional searching is required. Since little, if any, effort upon the Patent Office is required in such a situation, it is submitted that Patent Office policy, as embodied in M.P.E.P. '803, mandates that the full scope of the claims should be examined. M.P.E.P. '803 states that, when an entire invention can be searched without any additional search on the examiner, the examiner "must" search the full scope of the claims.

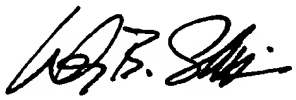
Applicants do not dispute that the claims of the catalysts are classified in a different subclass than the claims of the process, and further do not dispute that the catalyst as claimed

can conceivably be used in a materially different process. However, the inconsequential additional burden on the Patent Office respecting the treatment of claims of group II in the present case, contingent upon the allowability of claims of group I and the presentation of claims of group II which have the same breadth of the catalyst of allowable claims of group I, dictates examination of all the claims herein together.

In addition, the Restriction Requirement fails to take in account the fact that the claims of group II are related to the claims of group I as combination to subcombination. This is because the process claim 12 requires the catalyst Aof claim 1" therein. Accordingly, in the terms of the claim, the process cannot be conducted with a materially different catalyst, contrary to the indication in the Office Action. As stated in the M.P.E.P. '806.05(c), where the combination requires the particulars of the subcombination for patentability, as it does here, restriction is not proper. See the section entitled SUBCOMBINATION ESSENTIAL TO COMBINATION in the above-noted portion of the M.P.E.P. While it is noted that the claims of groups I and II could also be termed as related as product and process of use, as at page 2 of the Office Action, it is submitted that they are also related as combination/subcombination as noted above. The M.P.E.P. requires that where Aplural inventions are capable of being viewed as related in two ways, both applicable criteria for distinctness must be demonstrated to support a restriction requirement. See M.P.E.P. '803. Since the two-way distinctness required to support a restriction requirement for the combination/subcombination situation cannot be shown, as discussed above, the Restriction Requirement is improper, and should be withdrawn. Withdrawal of the Requirement for Restriction is therefore respectfully requested.

Should the Examiner have any questions or comments, she is cordially invited to telephone the undersigned at the number below.

Respectfully submitted,



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